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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,342	03/29/2000	Hironori Morito		6601

21171 7590 10/03/2003

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EXAMINER

LEE, TOMMY D

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/537,342

Applicant(s)

MORITO ET AL.

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-17 and 19-25 is/are rejected.
- 7) ☒ Claim(s) 10, 18 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,103,490 (McMillin).

Regarding claims 1-9, McMillin teaches a data converting apparatus comprising: a data converting part converting a set of input data into a set of image data that can be processed by an image forming apparatus forming an image on a medium in accordance with the set of image data (column 5, lines 24-41; column 6, lines 25-37); and a superimposing part superimposing at least two sets of image data converted from at least two different sets of input data so as to generate a single set of superimposed image data, wherein the image forming apparatus forms an image on the medium based on the single set of superimposed image data (column 6, lines 38-56). The data converting apparatus further comprises a data sending part sending the single set of superimposed image data to the image forming apparatus (column 6, lines 57-67); a form storing part selectively storing the set of image data converted from the set of input

data as a predetermined form that is superimposed, wherein said form storing part comprises a registration part registering the set of image data as a predetermined form that is superimposed (column 5, lines 24-30); a form selecting part selecting one of at least one predetermined form stored by the form storing part (column 7, lines 18-21); a form changing part changing the predetermined form stored by the form storing part, and a store control part selectively storing the predetermined form changed by the form changing part, wherein the form changing part changes layout information of the predetermined form on the medium, which information said form storing part stores by associating with the predetermined form (column 10, lines 3-42); and a previewing part previewing said single set of superimposed image data generated by said superimposing part (column 6, lines 63-68).

Claims 11-17 are method claims corresponding to above-rejected apparatus claims 1-9, respectively, and are thus rejected as well.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillin.

Claims 19-25 recite the steps of above-rejected method claims 11-17, respectively, as a program recorded on a computer-readable medium. Storage of a program for performing image processing step in general, while not taught by McMillin, is well known in the art, and it would have been obvious for one of ordinary skill in the art to provide a program for performing the steps taught by McMillin so that such steps may be performed by a computer, without requiring specific image processing hardware for performing each of the steps.

Allowable Subject Matter

7. Claims 10, 18 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to teach or suggest a limiting part limiting use of a predetermined form in accordance with limitation information stored in a form storing part in association with the predetermined form, as recited in claims 10, 18 and 26.

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,542,378 (Suganuma et al.) discloses a document processing method wherein a blank form and additional information for filling in the form are merged.

U.S. Patent 6,026,187 (Siegel) discloses the display of an original form and a blank document, with the blank document overlaying the original form.

U.S. Patent 6,594,405 (Flannery) discloses a method for completing preprinted forms wherein foreground data is printed onto the preprinted form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
September 29, 2003